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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,692	03/12/2001	Geoffrey B. Rhoads	P0328	1878

23735 7590 01/25/2005

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,692

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Slezak (U.S. Patent No. 6,006,257).

Referring to claim 1, Slezak discloses a method of providing media from a repository (video servers 520a-520c in Figure 1) to a consumer over the Internet (see Figure 1 and Column 5, Lines 34-40 for requesting a video program over the Internet through Web Server 40 and Column 5, Lines 40-51 for delivering the video program from a video server 520 to the subscriber 500 via the Internet 530).

Slezak also discloses permitting the consumer to specify whether the media is to include commercials or not (see Column 3, Lines 63-67 and Column 4, Lines 1-4 for prompting the user to select to view the movie with or without secondary content (i.e. advertising/commercials)).

Slezak also discloses charging the consumer a first fee for providing the media with commercials (see Column 3, Lines 66-67 and Column 4, Line 1 for charging half price (first fee) for a movie with secondary content (commercials) being shown during

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the movie).

Slezak also discloses charging the consumer a second fee higher than the first fee for providing the media without the commercials (see Column 3, Lines 64-66 for charging full price (second fee which is higher than the first fee) for viewing a movie with no secondary content (without commercials)).

For further examples of secondary content displayed during the presentation of the primary content, see Column 4, Lines 16-19, 30-32 and 45-48.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Lawler et al. (U.S. Patent No. 5,805,763).

Referring to claim 2, Slezak discloses that the media is video that is broadcasted (see Figure 2 and Column 5, Lines 63-67 for the video server used for outputting signals over a broadcast cable system) and is archived for Internet distribution (see Column 4, Lines 61-64 for providing primary and secondary content to the subscriber's house 500 via the Internet 530 and Column 5, Lines 13-16 for the video server 520 archiving the

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primary and secondary content that is deliver to the subscriber upon request (see Column 5, Lines 37-51), but fails to teach that the video was earlier broadcast.

Lawler discloses a system for accepting record requests at the headend, which stores broadcasted video that the viewer desires to record and view later upon request (see Column 5, Lines 17-21 for receiving broadcast programs at the headend and Column 13, Lines 26-33 for a recording device at the headend that monitors record tags (requests from the viewers) and if the user desires to record the program, records and stores the program so that a viewer can later view the television program on-demand), therefore providing video that was earlier broadcast.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the media distribution system, as taught by Slezak, to include a headend recording system, as taught by Lawler, for the purpose of reliably and easily program their systems to record future programs (see Column 1, Lines 40-42 of Lawler) and providing a single user to set a record tag for a program, allowing all viewers to access a single stored recording from the continuous media servers 32 (see Column 4, Lines 32-34), which allows users to conserve storage at the viewer's station controller.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 20, 2005

*Jaron
Salce*